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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,579	07/12/2001	Carl S. Chow	10007750-1	4263

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HEWLETT-PACKARD COMPANY
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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT PAPER NUMBER

3628

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/905,579	Applicant(s) CHOW, CARL S.	
	Examiner Akiba K. Robinson-Boyce	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Due to communications filed 4/25/06, the following is a final office action. Claims 1-18 have been cancelled. Claims 19, 22 and 27 have been amended. Claims 19-34 are pending in this application and have been examined on the merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 19-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, in independent claims 19 and 27, these claims were amended to recite "wherein the client does not specify an arrangement of components to create the document". The applicant points to Fig. 4 of the applicant's drawings as well as the written specification in its entirety for support of this amendment. However, these citations are unconvincing to the examiner. With reference to Fig. 4 of the applicant's drawings, step S212 describes a technical literature selection. However, technical literature is no more than an arrangement of technical components loaded into a literary document. In addition, the written specification describes determining publication characteristics in addition to the technical data. For example, on Page 2, paragraph 2

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of the specification, applicant describes that in addition to making a determination as to the content of a given publication, the overall theme, the general layout, the quantity of data contained, the level of detail provided, and the number and type of illustrations and/or photographs contained in the publication is disclosed. All of the specifications thus described relates to the arrangement of components to create a document. For example, when incorporating the number and type of illustrations and/or photographs contained in the publication, the components are represented by the illustrations and/or photographs since they are arranged by number and type in order to create the publication. Since the independent claims 19 and 27 were amended to recite "wherein the client does not specify an arrangement of components to create the document", this phrase causes the claims to fail to comply with the enablement requirement, thus this phrase can not be considered by the examiner in rejecting the claim. Since independent claims 19 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, the claims that depend from them are rejected as well (claims 20-26, and 28-34 respectively).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin (US 6,134,568) in view of Tonkin (EP 0621563 A1), hereinafter EP.

As for Claims 19, Tonkin discloses a method comprising:

providing a client interface, and a database containing information, wherein the client interface includes at least a portion of a network (see Fig. 1, also abstract, lines 1-6, interface, w/ col. 13, lines 54-56, database, w/Col. 3, lines 62-64, connected to a wide area network (WAN));

detecting a client inquiry via the interface (see Fig. 3, steps [202]-[204], determining if initial request was received, w/ Fig. 5A, shows a screen where user will enter a name for a new document to be retrieved);

presenting the information to the client via the client interface in response to the inquiry; (Fig's 5B-F, shows the presentation of information pertaining to the document during the request of document test); and

receiving a client selection of at least a portion of the information via the client interface in response to presenting the information, (Fig's 5B-F, shows the presentation of user selections during the request, for example user selects Volvo as the source file);

in response to receiving the client selection, assembling the selected information into a document..., (Col. 13, lines 17-30, user accepts document, and order request is transmitted, then the assembly of the document is facilitated);

obtaining an electronic image comprising:

the document, (figure 8A element 632), an image of selected binder, and figure 4, step 24, the user selects a different portion of the document]).

Tonkin does not specifically disclose a postage marking calculated based on a total weight of a booklet; and printing the electronic image onto one or more sheets of print media, but does teach a system which enables a user to preview a document by providing a user interface and inputting, via the user interface, information specifying an arrangement of components to create the document as shown in the abstract.

However, EP teaches, a postage marking calculated based on a total weight of a booklet; and printing the electronic image onto one or more sheets of print media, (col. 5, lines 43-56, indicates weight of a stuffed envelope to the franking machine so that proper postage may be printed on the envelope). EP discloses this limitation in an analogous art for the purpose of showing a system and method for preparing items for mailing, which calculates the postage and prints it on the booklet, wherein the postage amount is calculated by the total weight of selected items with known weights.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to calculate the exact postage for the booklet of Tonkin based on the total weight of the booklet and print the electronic image (including the postage) onto one or more sheets of print media at the document production locations (such as locations 71 to 73 in Fig. 1 of Tonkin), as taught by EP, for the purpose of charging proper postage to the corresponding booklet.

As Per Claim 27, Tonkin discloses:

providing a client interface, wherein the client interface comprises at least a portion of network, (see Fig. 1, also abstract, lines 1-6, interface, w/ col. 13, lines 54-56, database, w/Col. 3, lines 62-64, connected to a wide area network (WAN));

detecting a client inquiry via the client interface, (see Fig. 3, steps [202]-[204], determining if initial request was received).

presenting an information selection prompt via the interface in response to the client inquiry (Fig's 5B-F, shows the presentation of information pertaining to the document during the request of document test, where the selection prompt is represented by the drop-down box selection prompt);

receiving a client selection via the client interface in response to presenting the information selection prompt (Fig's 5B-F, shows the presentation of user selections during the request, for example user selects Volvo as the source file via drop-down box selection prompt);

accessing a read only memory device and retrieving selected data corresponding to the client selection; (figure 2, [element 154], read only memory);

in response to receiving the client selection, assembling the selected information into a document..., (Col. 13, lines 17-30, user accepts document, and order request is transmitted, then the assembly of the document is facilitated);

obtaining an electronic image comprising:

the document, (figure 8A element 632), an image of selected binder, and figure 4, step 24, the user selects a different portion of the document]).

Tonkin does not specifically disclose a postage marking calculated based on a total weight of a booklet; and printing the electronic image onto one or more sheets of print media, but does teach a system which enables a user to preview a document by

providing a user interface and inputting, via the user interface, information specifying an arrangement of components to create the document as shown in the abstract.

However, EP teaches, a postage marking calculated based on a total weight of a booklet; and printing the electronic image onto one or more sheets of print media, (col. 5, lines 43-56, indicates weight of a stuffed envelope to the franking machine so that proper postage may be printed on the envelope). EP discloses this limitation in an analogous art for the purpose of showing a system and method for preparing items for mailing, which calculates the postage and prints it on the booklet, wherein the postage amount is calculated by the total weight of selected items with known weights.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to calculate the exact postage for the booklet of Tonkin based on the total weight of the booklet and print the electronic image (including the postage) onto one or more sheets of print media at the document production locations (such as locations 71 to 73 in Fig. 1 of Tonkin), as taught by EP, for the purpose of charging proper postage to the corresponding booklet.

As for Claims 20 and 28, Tonkin further discloses:

presenting a name and address prompt via the client interface; and
receiving a client name and postal address, (Fig. 9 presents name and address, which occurs after the user specifies information in the document creation window).

As for Claims 21 and 29, Tonkin further discloses:

wherein the electronic image includes the client name and postal address (Fig. 9 presents name and address, which occurs after the user specifies information in the

document creation window, also see the computer system of EP reference includes the electronic image of the mail piece including the name and postal address).

As for Claims 22 and 30, Tonkin further discloses:

wherein the further selected information comprises an image to be purchased by the client, (figure 4 step 24, the user selects a different portion of the document], w/ Fig. 8A shows image in Tonkin).

As for Claims 23 and 31, Tonkin does not specifically disclose that the image is form of sheet music, but Tonkin does disclose various type of images, in the form of graphics, pictures, or various type of text.

It would have therefore been obvious to one having ordinary skill in the art to include the sheet music as one type of image for the purpose of printing text in the form of sheet music when requested by the client.

As for Claims 24 and 32, Tonkin further discloses:

wherein the image is artistic graphics, (see Fig. 8A).

As for Claims 25 and 33, Tonkin further discloses:

wherein the image is literary text (see Fig. 8A).

As for Claims 26 and 34, Tonkin further discloses:


wherein the image is technical data (see Fig. 8A).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 9am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


A. R. B.
November 16, 2006